

Remarks

Claims 480-498 are presently pending in the subject application.

Reconsideration and allowance are respectfully requested in view of the above amendments and the following remarks.

The title of the invention has been amended to more properly reflect the subject matter of the currently pending claims.

Claim 480 has been amended to indicate that the first and second base regions of the probe are complementary to each other. A definition of “complementary” is provided in the paragraph bridging pages 2 and 3 of the specification.. Because this amendment makes explicit what was implicit in the prior wording of the claim, Applicants submit that this amendment does not further limit the claim.

Claims 482, 484, 486 and 489 have been amended consistent with the amendment to claim 480.

Claim 495 has been amended to clarify that the nucleic acid analyte comprises RNA.

Rejection Under 35 U.S.C. § 112

Claims 480-498 stand rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite. In response to this rejection, Applicants have amended the claims to clarify that the claims are drawn to a kit comprising the probe previously recited in the preamble. Based on this amendment to the claims, Applicants respectfully request withdrawal of this rejection.

Rejection Under 35 U.S.C. § 102

Claims 490-498 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by Carmo-Fonseca et al. (1991) EMBO 10(7):1863-1873, as evidenced by Iribarren et al. (1990) Proc. Natl. Acad. Sci. USA 87:7747-7751. The Examiner’s rejection is predicated on the belief that Carmo-Fonseca discloses probe molecules in Table 1 that have first and second base regions which hybridize to each other. Applicants submit that the oligonucleotide sequences set

forth in Carmo-Fonseca do not contain self-hybridizing regions and, thus, shift the burden to the Examiner to provide credible evidence to the contrary. Claim 482 requires that the self-hybridizing portion of one these regions (i.e., the first base region) include a cluster of at least four 2'-O-alkyl modified ribonucleotides. Additionally, Applicants wish to point out that the Examiner has not demonstrated where, for example, Carmo-Fonseca discloses a conjugate molecule joined to an internal portion of a 2'-O-alkyl modified probe, a ribosomal RNA analyte, a target sequence having a double-stranded region, or a self-hybridizing probe having 2'-O-methyl substitutions. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 103

Claims 480-498 stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Carmo-Fonseca et al. (1991) EMBO 10(7):1863-1873, as evidenced by Iribarren et al. (1990) Proc. Natl. Acad. Sci. USA 87:7747-7751, in view of Tsang (U.S. Patent No. 5,837,442). Applicants submit that the reasons for this rejection do not overcome the deficiencies noted above in Carmo-Fonseca. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above amendments and remarks, Applicants submit that the subject application is in condition for allowance and notice to that effect is respectfully requested.

REPLY

Serial No. 09/808,558
Atty. Docket No. GP068-05.CN3

Please charge the fees due in connection with this Reply to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

Respectfully submitted,

Date: October 16, 2006

By: /Charles B. Cappellari/
Charles B. Cappellari
Registration No. 40,937
Attorney for Applicants

GEN-PROBE INCORPORATED
Patent Department
10210 Genetic Center Drive
San Diego, California 92121
PH: 858-410-8927
FAX: 858-410-8928